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To: Examiner Matthew D. Anderson, U.S. Patent and Trademark Office

Fax No.: 703-872-9306

Serial No.: 09/605,044

Title: Method And Apparatus For Maintaining Inventory Of Logical Volumes  
Stored On Storage Elements

From: Richard F. Glunta/Scott Gerwin

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Our File #: E0295.70117US00

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**MESSAGE:** Transmitted herewith are a Proposed Agenda and a copy of the claims as currently pending in this application.

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DOCKET NO.: E0295.70117US00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****RECEIVED  
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Applicant: David Black  
Serial No: 09/605,044  
Filed: June 27, 2000  
For: METHOD AND APPARATUS FOR MAINTAINING INVENTORY  
OF LOGICAL VOLUMES STORED ON STORAGE ELEMENTS

Examiner: Matthew D. Anderson  
Art Unit: 2186

Confirmation No.: 4788

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Eileen MacKenzie

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Applicant's attorney requests a telephone interview with the Examiner in relation to the Final Office Action mailed April 8, 2004 in application serial no. 09/605,044. The following agenda is proposed.

**PROPOSED AGENDA**

I. Applicant would like to discuss the rejection of claims 6, 8, and 10 under 35 U.S.C. §103(a) as purportedly being obvious over Fisher (6,247,096) and Blumenau (6,295,575). Blumenau and the present application are commonly assigned to EMC Corporation and qualifies as prior art only under 35 U.S.C. §102(e).

35 U.S.C. §103(c) states, "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Accordingly, Blumenau cannot be used in a rejection under 35 U.S.C. §103(a), so that the rejection of claim 6, 8, and 10 should be withdrawn.

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II. Applicant would like to discuss the rejection of the independent claims under 35 U.S.C §102(e) as being purportedly unpatentable over Fisher (6,247,096). Specifically, Applicant believes the limitation of claim 1 that recites, "for each of the plurality of logical volumes, maintaining identifying information for each user of the respective logical volume," is not disclosed or suggested by Fisher.

In Applicant's last response, filed March 12, 2004, Applicant argued that this limitation is not disclosed in the tables shown in Figures 5 and 6 of Fisher. In response to this argument, the Final Office Action mailed April 8, 2004 asserts that this limitation is disclosed at column 5, lines 1-7 of Fisher, where Fisher discloses that "[t]he tape management system database 41 allows the data storage system administration program to manage the data sets that resides on the volumes, including the expiration, owner, access, etc." (see Final Office Action, page 7, paragraph 27).

Fisher does not disclose that the term "owner" means a user. In fact, based upon the Data Facility Management System (DFMS) available from IBM that is disclosed at column 4, lines 60-63 of Fisher, Applicant believes that the owner is an administrator of the tape management system (see also <http://webdocs.caspar.it/ibm/web/tsm-5.1/mvs/html/guide/anrmgd41.htm>). Nothing in Fisher teaches that the owner information relates to identifying information for users of logical volumes.

Respectfully submitted,

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